

## REMARKS

Claims 1-2, 13-15, 23-29, 43-44, 54-56, 58, 65, and 67 are pending. Claims 3-12, 16-22, 30-42, 45-53, 57, 59-64, 66 and 68-70 have been canceled. Claims 54-56, 58, 65 and 67 have been withdrawn in response to a restriction requirement. Thus, Claims 1-2, 13-15, 23-29 and 43-44 are pending and at issue.

### **Rejections under 35 U.S.C. § 102(a)/103(a)**

Claims 1,2,13-15,23-25 and 43-44 are rejected under 35 U.S.C. § 102(a) as being anticipated by or, alternatively, obvious under 35 U.S.C. § 103(a) over Toki (WO 2003-014022) (hereinafter "Toki"); the rejection was based on its English language US national stage published application No. 2004/0197254. The Examiner contends that Toki teaches a dispersoid ingredient or a dispersoid having metal-oxygen bonds obtained by hydrolyzing or a partially hydrolyzing a metal alkoxide in the absence of an acid, base, and dispersion stabilizer.

The rejection is respectfully traversed, and reconsideration is requested.

To be available under 35 U.S.C. § 102(a)/103(a), a patented or printed publication must describe the invention "before the invention thereof by the applicant for patent." Toki lists the following as applicants/inventors: Motoyuki Toki, Akiji Higuchi, Nobuo Kimura, and Yoshitaka Fujita and is assigned to Nippon Soda Co. Ltd. Each of these applicants is an inventor of the present application, which is also assigned to Nippon Soda Co. Ltd. To prove this, an Affidavit under 37 CFR 1.132 showing attribution is submitted herewith.

Since each of the authors of Toki is an inventor in the present application, the invention was not conceived "before the invention thereof by the applicant for patent." Thus, Toki is unavailable as prior art under 35 U.S.C. § 102(a)/103(a) and applicants respectfully request that this rejection of claims 1,2,13-15,23-25 and 43-44 be withdrawn.

### **Rejection under 35 U.S.C. § 102(b)/103(a)**

Claims 27-29 are rejected under 35 U.S.C. § 102(a) as being anticipated by or, alternatively, obvious under 35 U.S.C. § 103(a) over U.S. Pat. 6,235,260 to Toki (the '260 patent). The Examiner argues that the '260 patent discloses a dispersoid which can be obtained in the absence of a multidentate stabilizer. In addition, the '260 patent teaches that an acid catalyst and/or a base catalyst may be used in hydrolysis. However, the '260 patent does not suggest the constituent of claims 27 and 28 of the present application, "in the absence of all members selected from the group consisting of an acid, a base and a dispersion stabilizer", at all.

A person of ordinary skill in the art would deservingly consider that an acid is an essential constituent in conducting the invention of the '260 patent regardless of the phrase "may be used" because an acid is used in all of the Examples 1-42 in the '260 patent. In addition, preferable acids are listed after the description of acid catalyst and/or base catalysts that may be used, including

mineral acid such as hydrochloric acid and organic acid such as acetic acid (col. 6 lines 60 – 62 and col. 8 lines 3 – 11). Considering the patent as a whole, and reading this portion of the '260 patent in context with the rest of the patent, a person of ordinary skill in the art is led to use an acid, and the use of acid or base is not optional. Furthermore, it is hard to avoid thinking that the '260 patent teaches that "using an acid" is necessary because hydrochloric acid headed in the list is used in all of the Examples 1-42 in the '260 patent.

On the other hand, because the dispersoids of claims 27 and 28 have stable structures without agglomeration even in the absence of an acid, a base or a dispersion stabilizer, it is possible to form films that are dense and have a smooth surface on any kind of substrate. Therefore, claims 27 and 28 are not only novel, but also unobvious over the '260 patent.

Furthermore, because claim 29 is dependent on claim 28, the rejections to this claim should also be overcome. Therefore, applicants respectfully request that the rejections of Claims 27 - 29 be withdrawn.

#### **Rejection under 35 U.S.C. § 103(a)**

Claims 26 is rejected under 35 U.S.C. § 103(a) as anticipated by or, alternatively, obvious under 35 U.S.C. 103(a) over Toki (W02003.014022).

The rejection is respectfully traversed, and reconsideration is requested.

To be available under 35 U.S.C. § 103(a) a patented or printed publication must describe the invention "before the invention thereof by the applicant for patent." Toki lists the following as applicants/inventors: Motoyuki Toki, Akiji Higuchi, Nobuo Kimura, and Yoshitaka Fujita and is assigned to Nippon Soda Co. Ltd. Each of these applicants is an inventor on the present application, which is also assigned to Nippon Soda Co. Ltd. To prove this, an Affidavit under 37 CFR 1.132 showing attribution is submitted.

Since each of the authors of Toki is an inventor in the present application, the invention was not conceived "before the invention thereof by the applicant for patent." Thus, Toki is unavailable as prior art under 35 U.S.C. § 103(a) and applicants respectfully request that this rejection of claim 26 be withdrawn.

**CONCLUSION**

Applicants respectfully submit that the application is in condition for allowance. Favorable consideration on the merits and prompt allowance are respectfully requested. In the event any questions arise regarding this communication or the application in general, the Examiner is invited to contact Applicants' undersigned representative at the telephone number listed below.

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Respectfully submitted,

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